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PATENT

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Lindsey Lin

Applicant : James C. Thomas, Jr. Confirmation No. 4976
Application No. : 09/927,296
Filed : August 10, 2001
Title : COMPUTERIZED SYSTEM FOR COMBINING INSURANCE
COMPANY AND CREDIT CARD TRANSACTIONS

Grp./Div. : 3627
Examiner : Elaine L. Gort

Docket No. : 45659/TJD/T503

**SUBMISSION OF APPELLANT'S BRIEF
TO THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Post Office Box 7068
Pasadena, CA 91109-7068
July 18, 2005

Commissioner:

Enclosed for filing are the **original and two copies** of Appellant's Brief for this application.

- _____ An extension of time to file Appellant's Brief is requested, and a Petition for Extension of Time and the applicable fee are enclosed.
- X Our check for \$250 to cover the fee for the appeal brief is enclosed.
- _____ An oral hearing of the appeal is requested, and our check for \$__, the fee for the oral hearing, is enclosed.

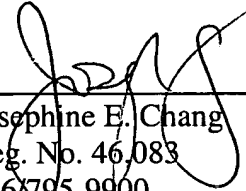
Application No. 09/927,296

The Commissioner is hereby authorized to charge any further fees under 37 CFR 1.16 and 1.17 which may be required by this paper to Deposit Account No. 03-1728. Please show our docket number with any charge or credit to our Deposit Account. **A copy of this letter is enclosed.**

Respectfully submitted,

CHRISTIE, PARKER & HALE, LLP

By


Josephine E. Chang
Reg. No. 46,083
626/795-9900

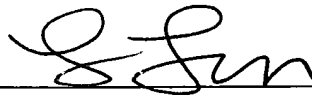
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1. REAL PARTY IN INTEREST

The real party in interest is James C. Thomas, Jr., the inventor for the application.

2. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences presently pending.

3. STATUS OF CLAIMS

Claims 23-32 are pending in the application. No claims have been allowed. The rejection of claims 23-32 are appealed.

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4. STATUS OF AMENDMENTS

No amendments were filed after the final Office action.

5. SUMMARY OF CLAIMED SUBJECT MATTER

This invention relates to a data processing system that provides rebates for charges made to a credit card as payments for insurance policies. For example, rebates accrued for using the credit card may be applied towards insurance policy premiums, policy upgrades, and the like. (Specification, p. 3, lines 22-26).

With reference to FIG. 1, a client 100 uses a browser client 110 to contact an interactive website 120 and establish a credit card account. The credit card account is linked to an insurance account provided by an insurance company. (Specification, p. 4, lines 21-26). Once the credit card account and the insurance account are linked, each client purchase using the credit card generates a rebate related to the purchase. (Specification, p. 5, lines 20-23.) For example, the rebate may be a percentage of the total purchase amount. (Id.) The rebate amount is then processed and deducted from the insurance account for insurance policy premium payments, health care expenditure, and the like. (Specification, p. 7, lines 2-9; p. 8, lines 5-9).

6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Whether claims 23-32 are unpatentable under 35 U.S.C. 103(a) over the article entitled "Shop - The Card You Pick Can Save You Money" in view of the article entitled "The Profitability of Credit Card Operations of Depository Institutions" and the Examiner's Official Notice.

7. ARGUMENT

Claims 23-32 stand rejected under 35 U.S.C. 103(a) as being unpatentable over the article entitled "Shop - The Card You Pick Can Save You Money" (the Shop article) in view of the article entitled "The Profitability of Credit Card Operations of Depository Institutions" (the Profitability article) and the Examiner's Official Notice.

The Examiner's rejection of claims 23-32 should be reversed because the Examiner has failed to establish a *prima facie* case of obviousness. Accordingly, claims 23-32 are allowable.

A. Introduction.

It is axiomatic that "[i]n proceedings before the patent and Trademark Office, the Examiner bears the burden of establishing a *prima facie* case of obviousness based upon the prior art." *In re Flitch*, 972 F.2d 1260 (Fed. Cir. 1992). This burden is satisfied "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." *Id.* (quoting *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988)). In rejecting the claims under appeal, the Examiner has failed to meet this burden.

B. The Examiner Has Failed to Establish a Prima Facie Case of Obviousness for Claims 23-28.

Claim 23 is written in independent form with claims 24-28 depending directly or indirectly from claim 23.

Independent claim 23 recites:

" A data processing system adapted to provide rebates for charges made to a credit card as payments for insurance policies, comprising:
a processor; and
a memory operably coupled to the processor and having program instructions stored therein, the processor being operable to execute the program instructions, the program instructions including:
generating a link between a credit card account and an insurance account associated with the insurance policy;
calculating a rebate amount based on a purchase amount charged to a credit card account using the credit card;
identifying the insurance account linked to the credit card account;
crediting the rebate to the identified insurance account linked to the credit card account; and
applying the credited rebate amount to an amount due on the insurance account."

The Examiner rejects claim 23 as obvious over the Shop article in view of the Profitability article and the Examiner's Official Notice. The Examiner contends that the Shop article "discloses the claimed data processing system adapted to provide rebates for charges

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made to a credit card," but acknowledges that it "is silent regarding a link between a credit card account and an insurance policy where the insurance account is credited with the rebate." (2/15/05 Final Office action, p. 2, par. 3). The Examiner, however, relies on the disclosure in the Profitability article to make up for this deficiency. Specifically, the Examiner relies on the disclosure on page 7, the 8th paragraph, which states:

"Under co-branding programs, the credit card bears the name of and is marketed to consumers of the co-branded product(s). Through use of the card, consumers typically accumulate 'points' good for rebates on purchases of the co-branded product(s). One popular type of co-branding is with airline companies; in this case, 'frequent-flier miles' are earned through credit card purchases."

Based on this disclosure, the Examiner contends that "it is known in the art to provide a credit card with a link between a credit card account and another account which is credited with a rebate . . . to simultaneously promote the credit card and the co-branded products." (2/15/05 Final Office action, p. 2, par. 4). The Examiner thus concludes that "[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the system of [the Shop article] with the link between a credit card account and another account which is credited with the rebate as taught by [the Profitability article], in order to promote the card and the co-branded products." (*Id.*)

Appellant respectfully submits that even the combination of the Shop article, the Profitability article, and the Examiner's Official Notice, fail to teach or suggest all of the limitations of claim 23. The Profitability article simply discloses that by using a co-branded credit-card, the user may "accumulate 'points' good for rebates on purchases of co-branded product(s)." For example, frequent-flier miles may be earned for a particular airline, and used as a rebate during the purchase of a ticket from such airline. Assuming, *arguendo*, that the limitation of "generating a link between a credit card account and an insurance account associated with the insurance policy" is met by interpreting the insurance account to be akin to a frequent-flier miles account, the Profitability article still fails to teach or suggest "applying the credited rebate amount to an amount due on the insurance account" as is required by claim 23. There is no "amount due" on a frequent-filer miles account. Again, the Profitability article simply teaches using points to purchase products. Nothing in the Profitability article teaches or

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suggests that such points are applied to "an amount due" on any type of "account," and much less, an "insurance account."

The Examiner takes Official Notice "that the use of memory, executable program instructions and processors is notoriously old and well known in the art of credit card usage and accounting to provide automated use, tracking and billing of credit card accounts." (2/15/05 Final Office action, p. 3, 1st full par.). However, claim 23 requires more than just an automated use, tracking and billing of credit card accounts. Claim 23 requires "generating a link between a credit card account and an insurance account associated with the insurance policy; . . . identifying the insurance account linked to the credit card account; . . . and applying the credited rebate amount to an amount due on the insurance account." (Emphasis added). Appellant submits that a memory storing these specific kinds of program instructions for execution by a processor is not "notoriously old and well known in the art." Accordingly, the Examiner has failed to set forth a *prima facie* case of obviousness with respect to claim 23.

Claims 24-28 are patentable because they depend directly or indirectly from claim 23, and because they contain additional limitations distinguishing them from the cited references.

C. The Examiner Has Failed to Establish a Prima Facie Case of Obviousness for Claim 29.

Claim 29 depends directly from claim 23. In addition to being patentable for the reasons stated for independent claim 23, claim 29 is further patentable over the prior art as it further recites "making payments from the insurance account to pay an insurance policy's premiums." In the Profitability article, any payments that are made are from the credit card account itself, and not from another account such as a frequent-flier miles account, and much less, from "the insurance account to pay an insurance policy's premiums." Accordingly, the Examiner has failed to set forth a *prima facie* case of obviousness for claim 29.

D. The Examiner Has Failed to Establish a Prima Facie Case of Obviousness for Claim 30.

Claim 30 depends from claim 29. In addition to being patentable for the reasons stated for claim 29, claim 30 is further patentable over the prior art as it further recites that "the type of

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insurance policy is selected from the group consisting of medical insurance, medical gap insurance, disability insurance, life insurance, and long term care insurance." There is no teaching or suggestion in the Profitability article that the disclosed co-branding applies to insurance policies, and much less, to the types of insurance policies recited in claim 30. Accordingly, the Examiner has failed to set forth a *prima facie* case of obviousness for claim 30.

E. The Examiner Has Failed to Establish a Prima Facie Case of Obviousness for claim 31.

Claim 31 depends from claim 23. In addition to being patentable for the reasons stated for claim 23, claim 31 is further patentable over the prior art as it further recites "making payments from the insurance account to pay for an upgraded insurance policy." In the Profitability article, any payments that are made are from the credit card account itself, and not from another account such as a frequent-flier miles account, and much less, from "the insurance account to pay for an upgraded insurance policy." Accordingly, the Examiner has failed to set forth a *prima facie* case of obviousness for claim 31.

F. The Examiner Has Failed to Establish a Prima Facie Case of Obviousness for Claim 32.

Claim 32 depends from claim 23. In addition to being patentable for the reasons stated for claim 23, claim 32 is further patentable over the prior art as it further recites "making payments from the insurance account to make co-payments for services provided under an insurance policy." In the Profitability article, any payments that are made are from the credit card account itself, and not from another account such as a frequent-flier miles account, and much less, from "the insurance account to make co-payments for services provided under an insurance policy." Accordingly, the Examiner has failed to set forth a *prima facie* case of obviousness for claim 32.

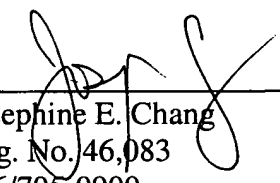
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G. Conclusion.

For these reasons, all pending claims 23-32 are patentable over the art of record and in condition for allowance. Reversal of the Examiner's decision is urged.

Respectfully submitted,

CHRISTIE, PARKER & HALE, LLP

By  _____
Josephine E. Chang
Reg. No. 46,083
626/795-9900



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8. CLAIMS APPENDIX

23. A data processing system adapted to provide rebates for charges made to a credit card as payments for insurance policies, comprising:

a processor; and

a memory operably coupled to the processor and having program instructions stored therein, the processor being operable to execute the program instructions, the program instructions including:

generating a link between a credit card account and an insurance account associated with the insurance policy;

calculating a rebate amount based on a purchase amount charged to a credit card account using the credit card;

identifying the insurance account linked to the credit card account;

crediting the rebate to the identified insurance account linked to the credit card account; and

applying the credited rebate amount to an amount due on the insurance account.

24. The data processing system of claim 23, further comprising an account management Web site operably coupled to the credit card account and the insurance account.

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25. The data processing system of claim 23, the program instructions further including calculating the rebate amount as a fixed percentage of the purchase amount charged to the credit card account.

26. The data processing system of claim 23, the program instructions further including calculating the rebate amount as a variable percentage of the purchase amount charged to the credit card account.

27. The data processing system of claim 26, the program instructions further including determining the variable percentage from the purchase amount charged to the credit card account.

28. The data processing system of claim 26, the program instructions further including determining the variable percentage from a balance amount of the credit card account.

29. The data processing system of claim 23, the program instructions further including making payments from the insurance account to pay an insurance policy's premiums.

30. The data processing system of claim 29, wherein the type of insurance policy is selected from the group consisting of medical insurance, medical gap insurance, disability insurance, life insurance, and long term care insurance.

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31. The data processing system of claim 23, the program instructions further including making payments from the insurance account to pay for an upgraded insurance policy.

32. The data processing system of claim 23, the program instructions further including making payments from the insurance account to make co-payments for services provided under an insurance policy.

IX. EVIDENCE APPENDIX

(None)

X. RELATED PROCEEDINGS APPENDIX

(None)

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